

REMARKS

Upon entry of the amendments herein, claims 1-5 remain pending in the application. Claim 1 has been amended and claims 6, 8 and 9 have been cancelled.

Claims 6, 8 and 9 have been rejected under 35 USC §112, first paragraph as not being enabled by the specification and for failing to comply with the written description requirement. These claims have further been rejected under 35 USC §112, second paragraph as being indefinite for failing to provide adequate description of the compound recited therein. In the interest of expediting execution of the application, Applicant has cancelled these claims. Applicant maintains the right to resume prosecution of these claims in a continuation application, and the action herein may not be construed as acknowledgement of the validity of the rejections. In any event, cancellation of these claims has rendered moot their rejection.

Claims 1, 2, 5, 6, 8 and 9 have been rejected under 35 USC §102(b) as being anticipated by US 5,912,235 to Hoeltje et al. The canceling of claims 6, 8, and 9 renders moot their rejection. Claim 1 has been amended herein to recite that the determination of the effect of a test compound on maximum gastric accommodation capacity in the test animal is made **after a ramp phase**. Support for this amendment can be found in the

specification on, for example, page 7, lines 5-7. The Hoeltje reference is silent with respect to this aspect of the instantly claimed invention and thus cannot be said to anticipate said invention. This rejection should be withdrawn.

Claims 6, 8 and 9 have been rejected under 35 USC §102(b) as being anticipated by US 5,552,398 to King et al. The canceling of these claims renders moot this rejection.

Claim 3 has been rejected under 35 USC §103(a) as being obvious over the previously cited Hoeltje reference in view of US 5,000,532 to Ui et al. Again, amended claim 1 makes clear the patentable distinction between the instantly claimed invention and the prior art.

During the ramp phase of the instantly claimed method, it is the passive relaxation, which is dependent on the elasticity of the stomach wall, that is measurable. During the tonic phase (i.e., after the ramp phase) of the instantly claimed method, wherein the maximum gastric accommodation capacity is determined, the value of the volume change per second is dependent on the active relaxation, the relaxation caused by vagal reflexes. The instant application clearly describes two distinct phases, the ramp and tonic phases, and the differences between them in the test protocol. In the cited primary reference of Hoeltje, however, there is no disclosure of a distinct ramp phase preceding the tonic phase.

In screening test compounds for their effectiveness in the treatment of an impaired maximum gastric accommodation capacity, a more accurate measurement is obtained by determining said capacity after a ramp phase. This is true because the results obtained reflect the influence of the vagal reflexes and are thus independent of any contribution from passive relaxation dependent on the elasticity of the stomach wall.

As set forth above, there is no teaching or even suggestion in the primary reference of the improved method of identifying a test compound useful for the treatment of an impaired maximum gastric accommodation capacity according to the instantly claimed invention. In rejecting pending claim 3, the Examiner has invoked the secondary *Ui* reference as disclosing the use of Wistar rats as test animals, which animals are specifically recited in the rejected claim. Regardless of whether or not the Examiner's assertion of the disclosure of *Ui* is valid, the fact remains that this secondary reference, just like the primary reference, is silent with respect to the ramp phase aspect of the instant invention. Therefore, the cited secondary reference cannot make up for the fundamental deficiency in the teaching of the primary reference, and the combined teachings of the two references would not lead one of skill in the art to the presently claimed invention.

Claim 4 has been rejected under 35 USC 103(a) as being obvious, again over the primary Hoeltje reference, this time in view of the previously cited King patent. This combination of references is ineffective as a bar to patentability for reasons similar to those discussed above for the first obviousness rejection. The Examiner acknowledges that the primary reference does not teach the compounds recited in instant claim 4 but asserts that the King reference makes up for this deficiency by disclosing 5HT-4 antagonists. Whether or not the Examiner's assertion with respect to the King reference is valid, the fact remains that this secondary reference, like the Ui reference, does not make up for the fundamental deficiency of the primary reference, because it too is silent with respect to the ramp phase aspect of the present invention. Accordingly, one of skill in the art would not be led to combine the Hoeltje and King references to come up with the instantly claimed invention.

Applicant is also submitting concurrently herewith, via an Information Disclosure Statement, two additional references to be made of record in the application prior to allowance. Consideration of these references is respectfully requested.

As set forth above, the claims pending in this application are free of the cited prior art. None of these claims were subject to a rejection under 35 USC §112. Reconsideration and allowance of the application with pending claims 1-5 are

respectfully requested. Should any other matters require attention prior to allowance, it is requested that the Examiner contact the undersigned.

The Commissioner is hereby authorized to charge any fees which may be due for any reason to Deposit Account No. 23-1703.

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Respectfully submitted,



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